

Remarks

The foregoing amendment does not involve new matter. Claims 15-17, 19-22, 24-26 and 28 have been amended in a non-limiting fashion to change their claim dependency.

In the outstanding Office Action, the previous restriction requirement was modified and made final. As a result, claims 1-31, 34-40 and 43-45 were deemed withdrawn from consideration. In the forgoing listing of the claims, the designation of "withdrawn" has not been used on those claims as some of them have been amended to depend from claims that have been elected. Once the restriction requirement has been finalized, withdrawn claims will be so designated.

In the outstanding Office Action, claims 32, 41, 42 and 46-60 were subject to yet another three way restriction requirement. Applicants hereby elect to prosecute the claims of Group I, claims 32 and 60. That election is made with traverse. Amended claims 15-17, 19-22, 24-26 and 28 also fit in this group.

The reason given in support of the restriction requirement for the restriction between Groups I, II and III is that they are subcombinations useable together in a single combination. In support of the restriction, it is alleged that the subcombinations have separate utility. However, the restriction is improper. First, the restriction has not identified what the combination is. It is therefore impossible to see if each of the groups of claims are really subcombinations of that combination, and then whether the test specified in MPEP§ 806.05(d) is appropriate.

Second, to be proper, the Office Action must suggest a utility of the claimed invention other than in the combination. While the Office Action gives a utility for each of the groups, it is unclear whether this is a utility that is separate from the utility in the combination.

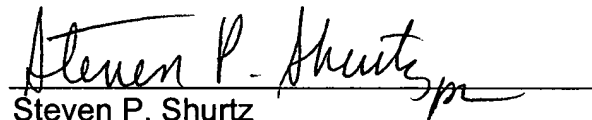
In reality, the restricted claims all relate to methods of manufacturing a hard disk drive. If the claims are considered to be subcombinations, and the combination is the method of manufacturing a hard disc drive, then the separate utility that must be identified for a proper restriction is a utility that is not part of the combination of making a

hard disc drive. Each of the purported separate utilities are in fact utilities that are involved in making a hard disc drive. The preamble of each of the independent claims in each of the three groups refers to hard disc drives. Thus we see that the claims are not distinct, but are part of the same invention and should be examined together.

If the Examiner believes that restriction is still proper, then an identification of the combination to which each of the alleged groups of claimed inventions is useable and their separate utility outside of that combination should be provided so that a proper evaluation can be made as to whether the restriction is proper.

Since Applicants did not elect the claims of Groups II or III, the species restrictions in the outstanding Office Action are not addressed. However, this does not mean that Applicants acquiesce to the species restrictions.

Respectfully submitted,


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